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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,479	02/15/2001	Glenn Petkovsek	USA-P-00-001	1689
7590	06/22/2005		EXAMINER	
			BORISOV, IGOR N	
		ART UNIT	PAPER NUMBER	
			3639	
DATE MAILED: 06/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/784,479  <b>Examiner</b> Igor Borissov	<b>Applicant(s)</b> PETKOVSEK, GLENN
<b>Art Unit</b> 3639	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 01 April 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     |  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
|  | 6) <input type="checkbox"/> Other: _____.  |

## DETAILED ACTION

### ***Response to Amendment***

Amendment received on 4/01/2005 is acknowledged and entered. Claims 1-3 and 12 have been amended. Claims 1-18 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. (US 2002/0120680 A1) in view of Heston (US 2002/0019741 A1).**

Greco et al. (Greco) teaches a method and system for providing electronic document services, comprising:

#### **Claims 1 and 12,**

providing a service provider server and user (client) computer; said server and user computer are configured to communicate over the Internet; said user computer includes a browser to locate said service provider on the Internet [0006]; [0051]; [0089];

providing a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084];

inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state, country) [0082]; [0084]; thereby indicating utilizing demographic and /or geographical information;

selecting a type of communication by one of the users [0062]; [0084];

automatically delivering an item by one of said document-related service [0062] – [0069];

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

Furthermore, Greco teaches that said server obtains necessary information from the user via convenient forms provided to the user [0089].

However, Greco does not specifically teach that said forms include *forms, which are used for creation said document* (communication).

Heston teaches a method and system for performing legal services over the Internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document [0105]; [0025]; [0006].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Greco to include that said database, residing in said service provider server remotely from the user computer, includes forms which are used for creation of a document, as disclosed in Heston, because it would advantageously simplify a whole process of creation of a document and delivering it to a recipient. Information as to *special service* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembicza* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior

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art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

**Claim 2**, Greco teaches means for inputting information (260) by each of the users [0053].

**Claim 3**, Heston teaches a plurality of forms stored in the database, said forms are to be used in creation of a document [0027]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Information as to *wherein the users may choose any one of the plurality of forms* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 3 are disclosed in Greco in view of Adams as described herein. Also as described the limitations of the claim 3 do not distinguish the claimed apparatus from the prior art.

Furthermore, Greco teaches:

**Claim 4**, a directory of addresses stored in the database [0013]; [0062].

**Claim 5**, means for generating addresses necessary for delivery based on information input by the user [0062]; [0071].

**Claim 6**, means for generating communications based on the information input by the user [0012].

**Claim 7**, means for suggesting mailing requirements based on information input by the user [0012].

**Claim 8**, means for computing postage costs and fees to the user associated with delivery by the special service [0097].

**Claim 9**, means for contacting a supplier necessary to complete delivery of the communication by the special service [0046].

**Claim 10**, means storing information by each of the users [0082]; [0084].

**Claim 11**, means for generating a report for the user [0097].

**Claim 13**, determining required services for delivery by the special service and costs associated with the delivery [0012]; [0097].

**Claim 14**, providing links to web-sites of said Internet-based document-related service providers [0084] based on information input by the user [0012] and location information (e.g., city, state, country) [0082]; [0084]; thereby obviously indicating utilizing demographic information.

**Claim 15**, Heston teaches: generating the communication based on the information input by the user [0013]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 16**, Heston teaches: providing the communication to the user via a display screen [0010]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 17**, Greco teaches: itemizing services taken by said Internet-based document-related service providers [0097].

**Claim 18**, Greco teaches: generating a report for the user [0097].

### ***Response to Arguments***

Applicant's arguments filed 4/01/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach a database that stores the communication, stores instructions to assist the user to completely prepare selection of the communication and stores requirements to effect the delivery the communication, it is noted that Greco teach this feature. Specifically,

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Greco teaches a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084].

In response to the applicant's argument that the prior art does not teach that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site, it is noted that Heston teaches that a client accesses a Web site to select a document that he wants to prepare, and enters information necessary to create the document [0105]; [0025]; [0006]. As per mailing step, Greco teaches this feature [0040].

In response to the applicant's argument that the prior art fails to teach the step of inputting information into said database regarding demographics or the user, and selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region, it is noted that Greco teaches inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state, country) [0082]; [0084]; thereby indicating utilizing demographic and /or geographical information; selecting a type of communication by one of the users [0062]; [0084]; and automatically delivering an item by one of said document-related service [0069].

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing document related services over the Internet. The motivation to combine modify Greco to include that said remote database, residing in said service provider server, includes forms which are used for creation of a document, as disclosed in Heston, would be to simplify a whole process of creation of a document and delivering it to a recipient.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Hayes, can be reached at (571) 272-6708.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

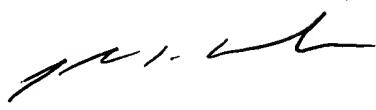
***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

IB

6/17/2005



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